

REMARKS

Claims 1-4, 24-56 and 72-82 are now pending. Claims 5-23 and 57-107 have been canceled without prejudice because they were drawn to unelected subject matter. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120 and § 121. Claims 108-118 are new. Support for the new claims can be found throughout the specification and claims as originally filed. Therefore, no new matter has been added.

Rejection for insufficient antecedent basis

The Examiner rejects Claims 27-29, 32-34, 38-40, 43-45, 49-51, and 54-56 for allegedly having insufficient antecedent basis in the base claim for the limitations “halophenyl” and “3-chlorophenyl.” Applicants respectfully contend that the base claim does have sufficient antecedent basis for the cited claim limitations.

An Applicant can be his own lexicographer; in the instant case, the term “aryl” is defined in Column 3, Paragraph [036] of the specification as “5-, 6-, and 7-membered single-ring aromatic groups that may include from 0 to 4 heteroatoms, for example, benzene.” One skilled in the art would readily understand that phenyl is the conventional aryl group counterpart to benzene. Furthermore, the specification states in Column 3, Paragraph [036] that “the aromatic rings can be substituted at one or more ring positions with such substituents as described above, for example, halogen.” Thus, both “halophenyl” and “3-chlorophenyl” have sufficient antecedent basis in the base claim, wherein R³ can be “aryl”.

Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection for lack of antecedent basis.

Rejection Under 35 U.S.C. § 102(b)

The Examiner rejects Claims 1-4, 27-28, and 35 under 35 U.S.C. 102(b) as “being clearly anticipated by Jones et al. CA134:100766. See RN 100829-98-8 anticipated formula I when R² is H, R³ is aryl, R⁴ is H, X is SO₂, n=m=l, and R¹=H.” See Figure 1. The Applicants respectfully disagree.

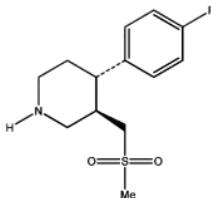


Figure 1: RN 100829-98-8: Piperidine, 4-(4-fluorophenyl)-3-[(methylsulfonyl)methyl]-, (3R,4S)-relative stereochemistry

The compound listed in the Chemical Abstracts Service's Registry File as RN 1100829-98-8 is listed as the product of the reaction in Example 6 of WO 01/004093. However, RN 1100829-98-8 is not the actual product of the recited Mitsunobu reaction. Rather, the compound name listed in Example 6 reflects a typographical error in the specification of WO 01/004093, which resulted in an incorrect entry in the CAS Registry.

Figure 2 depicts a reaction scheme consistent with Example 6 in the specification of WO 01/004093. The systematic name “*trans*-4-(4'-fluorophenyl)-3-(methylsulfonyl)methyl piperidine” is not the correct name of the product of the reaction (emphasis added). Instead, the correct systematic name of the product of the Mitsunobu reaction is “*trans*-4-(4'-fluorophenyl)-3-(methylsulfonate)methyl piperidine” (emphasis added).

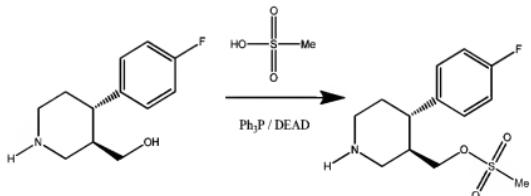


Figure 2: Diagram of the Mitsunobu reaction disclosed in Example 6 of WO 01/004093, showing the resultant compound contains a sulfonate group (-OS(O)₂), not a sulfonyl group (-S(O)₂).

Importantly, the actual product of Example 6 of WO 01/004093 does not meet all of the limitations of any of the rejected claims.

Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC § 102(b).

Rejection Under 35 U.S.C. § 103(a)

Examiner rejects claims 25, 26, 36-39, and 47-50 under 35 U.S.C. § 103(a) as being unpatentable over WO 01/004093, stating that “the anticipatory species has been delineated supra by CAS. The difference between the dependent claims and the anticipatory species is that the R² is methyl instead of hydrogen.” Applicants respectfully traverse the §103(a) rejection. For the reasons stated above, the cited reference does not anticipate any of the pending claims. Therefore, the Applicants respectfully contend that the Examiner has not stated a *prima facie* case of obvious for any of the rejected claims.

Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC § 103(a).

Non-statutory Obviousness-type Double Patenting Rejection

Examiner rejects Claims 1-4 and 24-56 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,517,892. Applicants respectfully traverse the rejection.

“Before consideration can be given to the issue of double patenting, two or more patents or applications must have at least one common inventor and/or be either commonly assigned/owned or non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3) pursuant to the CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)).” MPEP § 804. The instant application and the cited reference patent are not commonly owned or subject to a joint research agreement.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the non-statutory obviousness-type double patenting rejection.

FEES

The Applicants believe that they have provided for all of the required fees in connection with the filing of this Response. Nevertheless, the Commissioner is hereby authorized to charge any additional required fees to our Deposit Account, **No. 06-1448** reference **GUX-010.01**.

CONCLUSION

In view of the above remarks, it is believed that the pending claims are in condition for allowance. The Applicants respectfully request reconsideration and withdrawal of the pending rejections. The Applicants thank the Examiner for careful consideration of the present case. If a telephone conversation with the Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

Respectfully submitted,

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Date: December 16, 2010